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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,008	11/16/2001	Ludger Dinkelborg	SCH-1699 C1	7680

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MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

CANELLA, KAREN A

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/988,008	Applicant(s) DINKELBORG ET AL.	
	Examiner Karen A Canella	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 3, 4, 5, 8, 11-24 have been amended. Claims 1-24 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 5-24, drawn to compounds and use of compounds of the formula comprising a 'Cys-Ser-Ser-Leu-Met-Asp-Lys-Glu-Cys' motif within a cyclic peptide, classified in class 530, subclass 317. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-3, 5-24 will be examined with this group to the extent that they read on compounds and method reliant upon a cyclic peptide comprising the 'Cys-Ser-Ser-Leu-Met-Asp-Lys-Glu-Cys' motif.
- II. Claims 1-3, 5-24, drawn to compounds and use of compounds of the formula comprising a 'Cys-Ser-Ser-Trp-Leu-Asp-Lys-Glu-Cys' motif within a cyclic peptide, classified in class 530, subclass 317. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-3, 5-24 will be examined with this group to the extent that they read on compounds and method reliant upon a cyclic peptide comprising the 'Cys-Ser-Ser-Trp-Leu-Asp-Lys-Glu-Cys' motif.
- III. Claims 1-3, 5-24, drawn to compounds and use of compounds of the formula comprising a 'Cys-Phe-Thr-Tyr-Lys-Asp-Lys-Glu-Cys' motif within a cyclic peptide, classified in class 530, subclass 317. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-3, 5-24 will be examined with this group to the extent that they read on compounds and method reliant upon a cyclic peptide comprising the 'Cys-Phe-Thr-Tyr-Lys-Asp-Lys-Glu-Cys' motif.
- IV. Claims 1-3, 5-24, drawn to compounds and use of compounds of the formula comprising a 'Cys-Asn-Ser-Trp-Leu-Asp-Lys-Glu-Cys' motif within a cyclic peptide, classified in class 530, subclass 317. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-3, 5-24 will be examined with this group to the extent that they read on

compounds and method reliant upon a cyclic peptide comprising the 'Cys-Asn-Ser-Trp-Leu-Asp-Lys-Glu-Cys' motif.

- V. Claims 1-3, 5-24, drawn to compounds and use of compounds of the formula comprising a 'Cys-Lys-Asp-Met-Thr-Asp-Lys-Glu-Cys' motif within a cyclic peptide, classified in class 530, subclass 317. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-3, 5-24 will be examined with this group to the extent that they read on compounds and method reliant upon a cyclic peptide comprising the 'Cys-Lys-Asp-Met-Thr-Asp-Lys-Glu-Cys' motif.
- VI. Claims 1-3, 5-24, drawn to compounds and use of compounds of the formula comprising a 'Cys-Val-Tyr-Phe-Cys' motif within a cyclic peptide, classified in class 530, subclass 317. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-3, 5-24 will be examined with this group to the extent that they read on compounds and method reliant upon a cyclic peptide comprising the 'Cys-Val-Tyr-Phe-Cys' motif.
- VII. Claims 1-3, 5-24, drawn to compounds and use of compounds of the formula comprising a 'Cys-Asn-Asp-Met-Tyr-Ala-Glu-Glu-Cys' motif within a cyclic peptide, classified in class 530, subclass 317. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-3, 5-24 will be examined with this group to the extent that they read on compounds and method reliant upon a cyclic peptide comprising the 'Cys-Asn-Asp-Met-Tyr-Ala-Glu-Glu-Cys' motif.
- VIII. Claims 1-3, 5-24, drawn to compounds and use of compounds comprising cyclo (Trp-Asp-Pro-Val-Leu), cyclo (Glu-Ala-Ile-Leu-Trp) and cyclo (Trp-Asp-Pro-2-thienyl-Gly-Leu), classified in class 530, subclass 317. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-3, 5-24 will be examined with this group to the extent that they read on compounds and method reliant upon cyclo (Trp-Asp-Pro-Val-Leu), cyclo (Glu-Ala-Ile-Leu-Trp) and cyclo (Trp-Asp-Pro-2-thienyl-Gly-Leu)

- IX. Claims 1-24, drawn to compounds and use of compounds comprising a linear peptide wherein said linear peptide binds endothelin receptors, classified in class 530, subclass 300. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-24 will be examined with this group to the extent that they read on compounds and method reliant upon linear peptides that bind endothelin receptors.
- X. Claims 1-3, 5-24, drawn to compounds and use of compounds comprising pyrimidinyl-benzenesulfonamide radical, bipyridin-4-yl-benzenesulfonamide radical, caffeoylmyricerone radical or a (2-pyridyl)-propionic acid radical, classified, for example, in class 546, subclass 82. Because of the uncertainty of claims drawn to "Use" a more detailed classification for a method is not possible. Claims 1-24 will be examined with this group to the extent that they read on compounds and method reliant upon compounds comprising pyrimidinyl-benzenesulfonamide radical, bipyridin-4-yl-benzenesulfonamide radical, caffeoylmyricerone radical or a (2-pyridyl)-propionic acid radical wherein said compounds bind endothelin receptors.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-X are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Office and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups I-X differ in the compounds relied upon for "using". Because the search for the products relied upon for the methods of use would not be co-extensive, the search for the methods would also not be co-extensive.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A Canella whose telephone number is (571)272-0828. The examiner can normally be reached on 10 a.m. to 9 p.m. M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571)272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karen A. Canella, Ph.D.
6/24/2004


KARENA CANELLA PH.D
PRIMARY EXAMINER